

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Philippe R. Murcia

Art Unit: 1772

Serial No.: 10/081,034

Examiner: Donald J. Loney

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For:

TC 1700

COMPOSITE MATERIAL PANELING AND METHOD OF MAKING SAME

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

Response to the Office Action dated May 20, 2003, species 3 is provisionally elected for further examination. That is, claims 35-31 drawn to a product.

The restriction categorized Invention I claims 1-13 as being drawn to a process in claims 156, subclass 60; Invention II claims 14-24 as being drawn to an apparatus, classified in class 156, subclass 349; and Invention III claims 25-31, drawn to a product, classified in class 428, subclass 166.

CLASSIFICATION

The restriction requirement is traversed. Inventions I, II and III are essentially categorized under the same class 156 and thus the restriction is improper. Although Invention III is in Class 428, that is only because no products are identified in class 156. Instead, it contains the following note: "This class does not provide for products of manufacture. Class 428, Stock Material or Miscellaneous Articles," Thus, by direction, products of Class 428 fall under

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class 156. Just because the classification system arbitrarily moved products that otherwise would fall in class 156 to class 428 for convenience, does not give rise to proper restriction. Indeed, it is contrary to restriction practice to content that any product claims must be restricted from method and apparatus claims just because the classification manual provides for no products to be grouped in the same class as the method and apparatus but instead groups them in a different class with a notation to seek the products in that different class.

EXAMINER'S RATIONALE

The Examiner finds Inventions I and II distinct on the basis that the apparatus as claimed can be used to practice another and materially different process such as one which uses new material instead of recycled material and/or uses a plastic veneer instead of wood veneer because the materials are not limiting within the apparatus claims.

With all due respect, a process that used new material would not be chosen or obtained by claim element (B) of apparatus claim 14 so no viable alternative method based on use of new material instead of recycled material has been shown. Even if it were, the Examiner has not shown that substituting "new materials" for recycled ones is a material difference between methods. Further, the use of plastic veneer would not satisfy claim element (D) of apparatus claim 14, because means for transforming wood waste into sheets would be incapable of yielding plastic veneer. Indeed, even where plastic materials were substituted for wood waste, the "means for transforming wood waste" need to be capable of transforming plastic waste because of differences in characteristics between plastic and wood (melting point, hardness, etc.). The claim elements (E) - (H) of claim 1 recite various "means" that act on wood veneer, which does not mean they are capable of likewise acting on plastic veneer, because of differences in material characteristics between the two substances.

The Examiner finds Inventions I and III distinct on the basis that the product as claimed can be made by a materially different process such as one which does not ascertain abrasion and/or mechanical resistance of the materials used or uses new materials instead of recycled ones.

With all due respect, the step of ascertaining abrasion and/or mechanical resistance of the materials used in claim 1, while not in product claim 25, is merely a further limitation that makes claim 25 broader in scope in this respect. This is nothing more than a normal differentiation in claim scope, which is analogous to the use of dependent claims, but which is not grounds to impose restriction. Using new materials would not satisfy claim 25's recitation of recycled or waste strips being sandwiched between two sheets of wood veneer so the Examiner has failed to identify an "alternate" process that can make the recited product if new material were used instead of recycled material because such would result in a different product as well.

The Examiner finds Inventions II and III distinct on the basis that the apparatus as claimed can be used to make a materially different article such as one which uses new materials instead of recycled material and/or plastic veneer instead of wood.

With all due respect, if new materials were used in place of recycled ones for the apparatus of claim 14, claim element (B) could not be satisfied because the means for choosing a particular kind of recycled or waste material can not be satisfied by new material. Further, the Examiner has failed to show that such a substitution in material would make a materially different article than that claimed. If plastic veneer were used instead of wood veneer, claim element (D) of claim 14 could not be satisfied because plastic veneer is not made from wood waste and further an apparatus capable of transforming wood waste into wood veneer would not be so readily adapted to transform plastic material into plastic veneer because of material

characteristic differences between wood and plastic (such as hardness, melting point, etc.). The remaining claim elements (E)-(H) specifically recite acting on wood veneer, which does not mean their capabilities extend to acting on plastic veneer in a like manner.

Withdrawal of the restriction requirement is warranted and requested.

Respectfully submitted,



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